INDEX.

PETITION FOR WRIT OF CERTIORARI 1

(A) Summary Statements of Matters Involved..... 2

(B) Reasons Relied Upon for An Allowance of the Writ 4

BRIEF IN SUPPORT OF THE PETITION FOR CERTIORARI 5

Statement of the Case..... 5

The Opinions of the Court Below..... 5

Jurisdiction 6

The Issues 6

Grounds for Granting Certiorari..... 6

Industry Concentrated in a Single Circuit..... 7

The Difference in Principle Among the Circuits..... 8

The Claim, and Not the Claim as Modified by the Specification, Measures the Grant..... 11

Deleterious Results of This Confusion..... 12

TABLE OF AUTHORITIES.

Cases.

Altoona v. Tri-Ergon Corp., 294 U. S. 477..... 11

Baldwin v. Paine, 90 Fed. (2) 1 (C. C. A. 6)..... 4

British, Thomson-Houston v. Charlesworth, 42 R. P. C. 180 9

Electric Battery v. Shimadzu, 307 U. S. 8..... 6

General Electric v. Wabash, 304 U. S. 364.....10, 11

Graver v. Linde Air, 336 U. S. 271..... 9

Keller v. Adams-Campbell, 264 U. S. 314..... 6

Lamson v. Hillman, 123 Fed. 416 (CCA 7)..... 11

Leeds & Catlin v. Victor, 213 U. S. 301..... 8
MacKay v. Radio, 306 U. S. 86..... 7
Mast v. Dempster, 82 Fed. 327 (CCA 8)..... 11
McCarty v. Lehigh, 160 U. S. 110..... 11
Milcor Steel v. Fuller, 316 U. S. 143..... 11
Mumm v. Decker, 301 U. S. 168..... 10
Muncie v. Outboard, 315 U. S. 759..... 7
Schriber v. Cleveland Trust, 305 U. S. 47..... 7
Solomon v. Renstrom, 150 Fed. (2) 805 (C. C. A. 8)... 4
Sontag Stores v. Nut Co., 310 U. S. 281..... 6
Textile v. Hirsch, 302 U. S. 490..... 10
Wayne v. Humble Oil, 175 Fed. (2) 230..... 5,8
Wayne v. Texas Company, 175 Fed. (2) 234..... 5,8
Yates v. Jones, 82 U. S. P. Q. 337, ... Fed. (2) 5,9

Text.

Terrell on Patents (British), pp. 121-123..... 9

Statutes.

28 U. S. C., Sec. 1254..... 6
28 U. S. C., Sec. 1404(a) 12

In the Supreme Court of the United States

OCTOBER TERM, 1949.

No. .....

THE MIDLAND STEEL PRODUCTS COMPANY,
Petitioner,

vs.

CLARK EQUIPMENT COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT.

To the Honorable Fred M. Vinson, Chief Justice of the United States Supreme Court and Associate Justices of the Supreme Court of the United States:

Your Petitioner, The Midland Steel Products Company, respectfully prays for a Writ of Certiorari to the Circuit Court of Appeals for the Sixth Circuit to review the judgment of that Court entered May 31, 1949 (Supplemental Transcript of Record and Proceedings in United States Court of Appeals—Sixth Circuit at page 41) in a suit for alleged infringement of four patents (rehearing denied July 25, 1949) affirming the judgment of the District Court, for the Western District of Michigan, Southern Division (Vol. I, p. 87; 75 F. S. 143), and directing that the Complaint (Vol. I, pp. 1-6) be dismissed.

A transcript of the record in the cause, including the proceedings of said Circuit Court of Appeals, has been furnished in accordance with the rules of this Court.

(A) Summary Statements of Matters Involved:

This cause is a patent infringement cause involving four patents relating to thick tube welding.* The District Court held that the Respondent was estopped to deny validity of the patents and this holding was not disturbed by the Court of Appeals.

Both Courts held non-infringement with respect to each of the four patents. Although the drawings, Figs. A, B, C and D hereof, illustrate only a single feature of the invention, of the patents and of the claims involved, that feature will serve to illustrate the specific law questions upon which this Petition is based.

Figs. A and B show a seam to be welded which is open for its full depth, i.e., from the top 1a to the bottom 2a. Figs. C and D show a seam which is open at the top 1c, but closed at the bottom 4c, and hence open for less than the full depth. Figs. A and B represent a preferred form of the inventor of the patents in suit. Figs. C and D show the form which the Courts concluded the defendant (respondent here) employed.

The edges of the seam are molten and a fusion weld is effected by bringing the edges together under pressure. In the preferred form the edges may be molten for the full depth of the seam as shown in Figs. A and B hereof and as is illustrated in Fig. 15 of Patent 1,948,801 (Vol. III, p. 912) or, as stated in Patent 1,948,801, they may "not be actually melted for their full depth" (Cl. 1, col. 1, ll. 33-

---

* For many uses thick walled tubes must be "worked," i.e., expanded, contracted, and otherwise mauled to make such articles as banjo axle housings (Vol. III, p. 914). Unless the characteristics of the tube were uniform it would crack, spread too thin, or otherwise be defective in parts. Prior to the inventions of the patents in suit "seamless tube" was used; this was made by punching a tube out of a billet, an expensive and laborious proceeding. Many efforts and failures had been made to weld a seam tube which would be as good as the "seamless tubes." That result was finally achieved by the inventions of the patents in suit and has been accepted and used as a solution.

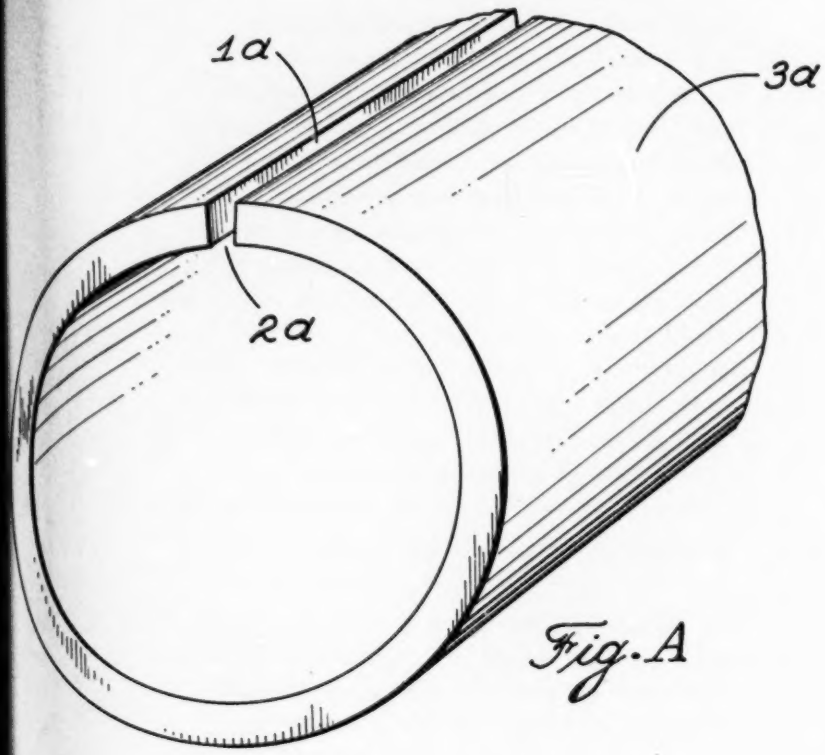

Fig. A

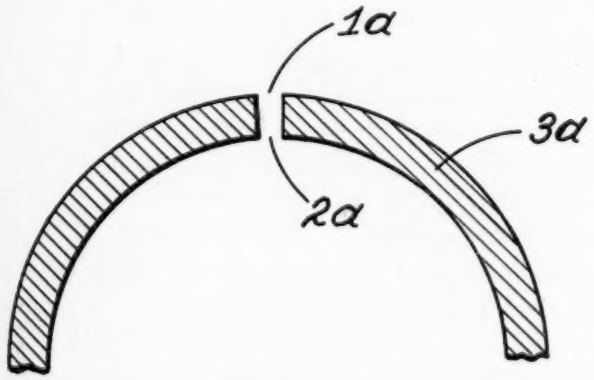

Fig. B

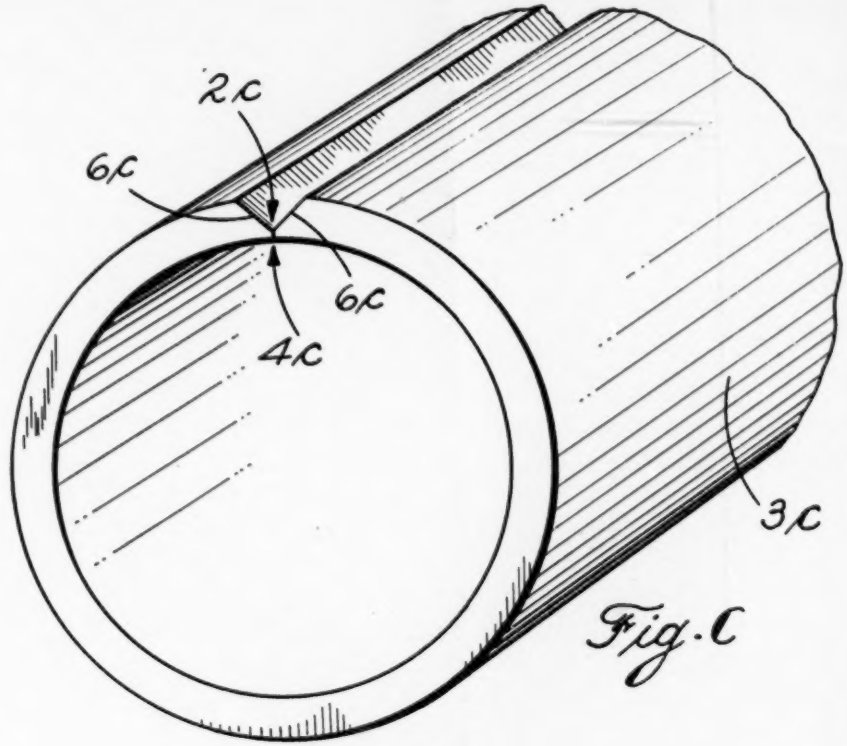

Fig. C

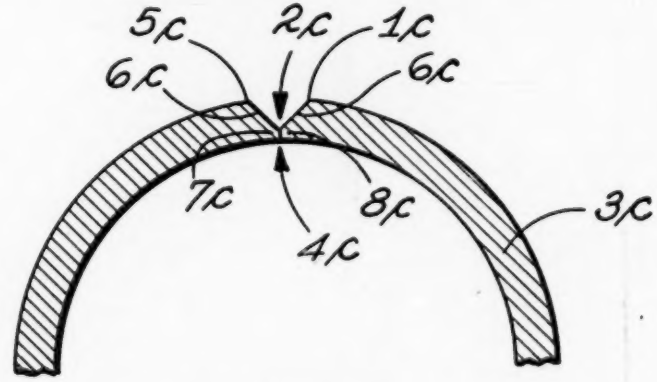

Fig. D

34). In Respondent's practice, as found by the Courts below, the edges are molten for less than the full depth as shown in Figs. C and D hereof and as is illustrated in Fig. 5 of the Catlett Patent 2,282,032 (Vol. IV, p. 1115), and a fusion weld is performed between the molten parts of the edges, just as in the case of the preferred form of the patented practice as shown in said Figs. A and B. The difference between plaintiff's preferred form and Defendant (respondent here) is, therefore, one of degree and not one of kind, as the Sixth Circuit Court of Appeals held (174 Fed. (2) 544). This difference of degree, as the same Court held, would not avoid infringement, except that the limitation to the full depth was construed erroneously, or read into the unambiguous claims in suit by that Court, as we point out hereinafter.

The inventions are defined by the claims grouped as follows:

(1) The patents contained a number of claims in suit reciting the preferred form, i.e., the seam open both at the top and bottom and the edges molten for their full depth. Such are the following: Patent 1,810,112, claims 1, 2 and 3; Patent 1,948,801, claim 8; Patent 2,139,771, claims 7 and 18, as is shown in said Figs. A and B.

(2) A second group of claims in suit refers to the open seam, but unlike the other claims does not specifically recite that the seam was open for its full depth, was open at the bottom and the top, or molten for the full depth. These claims are as follows: Claims 1, 4, 8 and 16 of Patent 2,139,771 and claims 3, 5 and 7 of Patent 1,948,801.

(3) Other claims did not recite the open seam or the molten edges at all. These are claims 16 of Patent 2,139,771, and claims 26 and 30 of Patent 2,061,671.

(4) Claims 3, 5 and 7 of patent 1,948,801 appear in a patent whose specification specifies that the invention is not limited to a seam whose edges may not be actually molten for the full depth.

This Petition is limited to the claims in Groups (2), (3) and (4).

(A) The Court of Appeals in the Sixth Circuit interpreted the claims in Groups (2) and (4) in "the light of the specification" to be limited to a seam open for its full depth and molten for the full depth.

(B) The Court of Appeals in the Sixth Circuit read the "full depth" seam and the melting for the full depth into the claims in Group (3) and held as so limited that the claims were not infringed.

The District Court made no analysis of the claims with respect to their variation in limitations in the respects discussed *supra*, or their relation to the specifications.

(B) **Reasons Relied Upon for An Allowance of the Writ:**

(1) Conflict and confusion among and between the rulings of different Circuit Courts of Appeals with regard to:

(a) the interpretation of an unambiguous patent claim "in the light of the specifications";

(b) reading features or elements not appearing in a claim into the claim "in the light of the specification."

These are questions of law (*Solomon vs. Renstrom*, 150 Fed. (2) 805, 808 (C. C. A. 8); *Baldwin vs. Paine*, 90 Fed. (2) 1, 3 (C. C. A. 6).

Wherefore, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the Court of Appeals for the Sixth Circuit, for review and determination of the judgment of said Court of Appeals.

THE MIDLAND STEEL PRODUCTS COMPANY,

By F. O. RICHEY,
H. F. MCNENNY,
Counsel for Petitioner.

In the Supreme Court of the United States

OCTOBER TERM, 1949.

No. .....

THE MIDLAND STEEL PRODUCTS COMPANY,
Petitioner,

vs.

CLARK EQUIPMENT COMPANY,
Respondent.

BRIEF IN SUPPORT OF THE PETITION FOR CERTIORARI.

STATEMENT OF THE CASE.

I.

The Opinions of the Court Below: The opinion of the Sixth Circuit Court of Appeals in the instant cause is reported at 174 Fed. (2) 541 and appears in the Supplemental Transcript of Record and Proceedings in United States Court of Appeals—Sixth Circuit, pp. 41-50 of the record.

The opinion of the District Court in the instant cause is reported at 75 Fed. Supp. 143 and appears in Vol. I, pp. 64-85 of the record.

Findings of Fact and Conclusions of Law of the District Court appear at 75 Fed. Supp. 153 and 154 and in Vol. I, pp. 85 and 86 of the record.

The decision of the Fifth Circuit Court of Appeals in *Wayne v. Humble Oil* appears at 175 Fed. (2) 230 and of *Wayne v. Texas* at 175 Fed. (2) 234.

The decision of the Fourth Circuit Court of Appeals in *Yates v. Jones* appears at 82 U. S. P. Q. 337, ... Fed. (2) .....

II.

(1) Jurisdiction of this Honorable Court is invoked under Title 28, United States Code, Section 1254.

(2) The date of the judgment below is May 31, 1949 (Proceedings in U. S. Court of Appeals—Sixth Circuit, p. 41). Petition for Rehearing was filed June 20, 1949 (Proceedings in U. S. Court of Appeals—Sixth Circuit, p. 51), and denied by the Court of Appeals on July 25, 1949 (Proceedings etc., p. 59).

(3) This suit is an Equity suit arising under the patent laws of the United States, and the judgment of the Circuit Court of Appeals for the Sixth Circuit requires that the Complaint in the suit be dismissed on the patent cause.

III.

The Issues Are:

(1) May an unambiguous claim be expanded or contracted by reference to the specification?

(2) May an unambiguous claim be expanded or contracted contrary to the specification?

(3) May an element or step which is not in an unambiguous claim be read into the claim from the specification to expand or contract the claim?

Grounds for Granting Certiorari:

(1) This Court has consistently granted Petitions for Certiorari where there was direct conflict of decisions between Circuit Courts of Appeals on particular patents or on patent principles (*Keller v. Adams-Campbell*, 264 U. S. 314; *Sontag Stores v. Nut Co.*, 310 U. S. 281; *Electric Battery v. Shimadzu*, 307 U. S. 8). All three cited cases are cases in which this Court granted Certiorari to settle differences in principle and practice in different Circuits.

Such a situation exists here, not only between two Circuits, but among various Circuits.

(2) **Industry Concentrated in a Single Circuit:** The principal and almost exclusive use of the product of the patented invention is involved in the manufacture of parts for motor cars used in the manufacture thereof, just as are aluminum pistons which were the subject-matter of the patents involved in *Schriber v. Cleveland Trust*, 305 U. S. 47. In that case this Court granted certiorari because litigation elsewhere, which might result in conflicting decisions, was improbable because of the concentration of the automobile industry in the Sixth Circuit. Precisely the same situation exists in the instant cause. The axle housings involved here are just as esoteric to the motor car industry concentrated in the Sixth Circuit as the aluminum piston was when this Court granted certiorari in *Schriber v. Cleveland Trust*. This policy has been followed by this Court since the rendition of its decision in the aluminum piston case (*MacKay v. Radio*, 306 U. S. 86, 89; *Muncie v. Outboard*, 315 U. S. 759, 766).

In *Muncie v. Outboard* this Court said (pp. 765, 766):

> "While there was no conflict of decision with respect to these claims, we granted certiorari in view of the questions presented and because the patent dominates a substantial portion of an industry so concentrated in the Seventh Circuit that litigation in other circuits, resulting in a conflict of decisions, is unlikely. 314 U. S. 594. Schriber-Schroth Co. v. Cleveland Trust Co., 305 U. S. 47."

In *Schriber v. Cleveland Trust* this Court said (p. 50):

> "We later granted certiorari, 304 U. S. 587, on a petition for rehearing showing that, notwithstanding the doubtful validity of the patents, litigation elsewhere with a resulting conflict of decision was improbable because of the concentration of the automobile industry in the sixth circuit. Cf. Paramount Publix Corp. v. American Tri-Ergon Corp., 294 U. S. 464; Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U. S. 477."

The Difference in Principle Among the Circuits relates to a Court referring to the specification of a patent to construe, to contract, or to expand an unambiguous claim in a patent.

The diversity of view is well illustrated by the resort to that practice of the Court of Appeals in the Sixth Circuit in the instant cause to construe and to contract unambiguous claims so as to put certain limitations upon them. This is illustrated by the following statement in the instant cause by the Court of Appeals (174 Fed. (2) 541 at 545-546, Proceedings, etc., p. 49):

> *"Certain of the claims, it"* (the patentee) *"urges, say nothing about the full depth of the seam or the reduction of the edges to a molten condition for their full depth, and therefore it urges that these elements may not be read into such claims.* The inventor's concept of his invention so clearly involves the spaced-apart edges and their molten condition to their full depth that *none of the claims may,* **in the light of the specifications,** *be interpreted without recognition of that concept,* and the steps in the method which are expressed in the claims, are a necessary and inescapable response to it." * (Emphasis herein ours unless otherwise indicated.)

The Court then construed and restricted the claims in Groups (2) and (3) *supra,* and held non-infringement of the claims as thus restricted.

A practice and a principle clearly contrary to the above practice in the Sixth Circuit was followed in the Fifth Circuit in the cases of *Wayne v. Humble Oil,* cited *supra,* and *Wayne v. Texas Company,* 175 Fed. (2) 234. There the

---

* The inventor's concept of his invention is the combination, a legal entity separate from any element or step (*Leeds & Catlin v. Victor,* 213 U. S. 301). Therefore, a single element or step is not the concept of the invention. If it were the inventor would not have omitted it from some of his claims and stated in the specification of one of the patents in suit (1,948,801) that that element or feature said to be the concept of his invention may not be present in an embodiment of the invention.

Court refused to refer to the specification to construe a claim to contract it, saying (175 Fed. (2) 234):

> "Ambiguity in language may be cleared up by reference to the specifications, *but the claim, when unambiguous, can neither be expanded nor contracted thereby.* Graver Mfg. Co. v. Linde Air Products Co., 336 U. S. 271, 277, 69 S. Ct. 535."

In *Yates v. Jones, supra,* the Court of Appeals for the Fourth Circuit restricted unambiguous claims in the light of the specification, saying (82 U. S. P. Q. 338):

> "Thus, the claims, in the light of the specifications, must be rather narrowly construed."

Manifestly, unless this Court decides which of these antithetical practices or policies is to be followed, the confusion which now exists will continue to the great waste of the time of the Courts and the time and money of litigants. No one, of course, can reconcile these differences except this Court.

It is our contention that the policy of the Court of Appeals in the Fifth Circuit is correct and that of the Sixth Circuit in the instant cause is erroneous for the reason that a patent is a contract and the patent, or any portion thereof such as a claim, represents the final memorial of the intention of the parties, and resort may not be had to extraneous matter to interpret an unambiguous contract or an unambiguous section of a contract. This is also the rule in the English Courts. (*British, Thomson-Houston vs. Charlesworth,* 42 R. P. C. 180, 208; *Terrell on Patents* (British) pp. 121-123.)

This ancient and general rule of the law of contracts was followed by the Fifth Circuit Court of Appeals and by this Court in a patent case in *Graver v. Linde Air,* 336 U. S. 271, 277, cited by the Fifth Circuit Court of Appeals which conforms to the rule in the English Patent Courts. (*Terrell on Patents, supra.*) The rule was ignored by the Sixth Circuit Court of Appeals in several particulars, as follows:

(1) Resort was had to the specification of Patent 2,139,771 to construe into claims 1, 4, 8 and 16 a seam, and restrict these claims to a seam, open for its full depth and molten for the full depth thereof, although these features do not appear in these particular claims. (They do appear in otherwise coextensive claims in the patent, showing clearly the intention not to include them in these particular claims.) Nevertheless, the Court of Appeals referred to the specification describing the preferred form of the invention and expanded the claims to contain these limitations (174 Fed. (2) 545-546).

(2) Claims 3, 5 and 7 of Patent 1,948,801 do not recite either the opening for the full depth or the melting of the edges for the full depth. The Court of Appeals in the Sixth Circuit referred to the specification and construed these limitations into the claims though the specification says that the edges may "not be actually melted for their full depth." Thus, though presuming to follow the policy of construing unambiguous claims in the light of the specification, the Court construed them contrary to the specification.

(3) Claim 16 of Patent 2,139,771 and claims 26 and 30 of Patent 2,601,671 do not recite the open seam or the molten edges at all. The Court of Appeals of the Sixth Circuit, therefore, bodily read these features into these three claims from the specification.

When such confusion in principle or policy exists between or among the Circuit Courts of Appeals as we have shown above, the deleterious effects are of far greater compass than where the differences relate to a confusion in view regarding a particular patent, a condition which has universally resulted in certiorari by this Court (*G. E. vs. Wabash*, 304 U. S. 364; *Textile vs. Hirsch*, 302 U. S. 490; *Mumm v. Decker*, 301 U. S. 168).

The Claim, and Not the Claim as Modified by the Specification, Measures the Grant, as this Court has frequently held (see, for example, *Milcor Steel v. Fuller,* 316 U. S. 143, 145; *General Electric v. Wabash,* 304 U. S. 364, 369; *Altoona v. Tri-Ergon Corp.,* 294 U. S. 477, 487. There would be little purpose in such holdings if unambiguous claims could be construed to include a part of the specification for then it would not be the claim which measured the grant, but the claim as modified "in the light of the specification." Moreover, there would be little reason for requiring the claims to be separately written if they are not to be separately read. If a claim which is written separately from the specification were read "in the light of the specification," it would not then be read separately from the specification.

We do not mean here to say that resort might not be had to the specification to construe an ambiguous claim. The claims here are not ambiguous. There is no evidence and no finding that any claim involved is ambiguous. But, even where the claim is ambiguous, reference to the specification may be had only for purposes of construction and not to read an element or feature into or out of a claim (*McCarty v..Lehigh,* 160 U. S. 110, 116) and not to construe an element or feature into a claim so as to make it coextensive, or substantially coextensive, with some other claim. (*Mast v. Dempster,* 82 Fed. 327, 333 (CCA 8); *Lamson v. Hillman,* 123 Fed. 416, 419 (CCA 7)). In the latter case the fact that the claims differ show that it was the intent of the constructor of the claims that they should be read as they are written and such presumption overcomes any construction that might be placed upon an ambiguous claim by reference to a specification to make it coextensive with the other claim.

In the instant cause, however, as we have said, not only are the claims unambiguous, but to construe them as the Court of Appeals for the Sixth Circuit did "in the light of the specification" would be to make them coextensive with

other claims so that not only has the cardinal rule that an unambiguous claim measures the grant and must be read separately from the specification been violated, but the rule that a claim, whether ambiguous or unambiguous, may not be construed "in the light of the specification" to make it coextensive with other claims in the patent has also been violated.

Deleterious Results of This Confusion: In view of the instant conflict lawyers cannot know how to advise clients regarding the scope of claims, or how that scope may be affected by the specification, if at all. Attorneys do not know what the attitudes of particular Courts in the several Circuits will be upon these subjects though, in the confidence that the Courts in a certain Circuit will follow a policy most favorable to a particular patent claim, the parties will not only maneuver to secure, or not to secure, the jurisdiction of the Court that seems most favorable, but since the passage of the Transfer Statute (Title 28, U. S. C., Sec. 1404(a))* Motions and other efforts will be made to transfer a cause from what seems to be an unfavorable jurisdiction to a favorable jurisdiction. All of this not only causes great expense to litigants, but great annoyance, and places great burdens upon the Courts. There was every reason to reconcile such differences as exist in the cause at bar even before the passage of this Transfer Statute, but the enactment thereof makes the reason for settling these matters all the more important, not only in the interests of the parties, but in the interests of the Courts themselves.

Indeed, the expense and work caused by such confusions go a long way toward reducing, and in some cases makes a mockery, of the reward promised the inventor by Congress and the Constitution under the patent laws.

---

* "Title 28, Section 1404. Change of Venue.

(a) For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought."

While the purposes of most laws are to settle controversies without breach of the peace, the purpose of the patent laws is to encourage invention by rewarding the inventor with a patent. It is important, therefore, not to negative the reward and the purpose of the laws by leaving the administration of the laws in such confusion that the burden of adjudicating a patent will outweigh the advantages of the patent reward and the patentee will have lost by his invention instead of gaining thereby, as was intended by Congress and the Constitution even when, and if the judgment is in his favor.

Your Petitioner, therefore, prays that this Court will reconcile these differences and prevent these confusions from proceeding further or arising in the future.

Respectfully submitted,

F. O. RICHEY,
H. F. MCNENNY,
Counsel for Petitioner.

RICHEY & WATTS,
1150 Union Commerce Bldg.,
Cleveland, Ohio,
Of Counsel.

FILE COPY

FILED
NOV 26 1949
CHARLES ELMORE CROPLEY
CLERK

In the Supreme Court of the United States

OCTOBER TERM, 1949.

No. 409.

THE MIDLAND STEEL PRODUCTS COMPANY,
Petitioner,

vs.

CLARK EQUIPMENT COMPANY,
Respondent.

REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

F. O. RICHEY,
H. F. MCNENNY,
Attorneys for Petitioner.

RICHEY & WATTS,
1150 Union Commerce Bldg.,
Cleveland, Ohio,
Of Counsel.

THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO—MAIN 8547

TABLE OF CASES.

Graver v. Linde Air, 336 U. S. 217, 93 Law Ed. Advance Opinions p. 496 ..... 2, 3

Merrill-Ruckgaber v. U. S., 241 U. S. 378..... 1, 2

Wayne v. Humble, 175 Fed. (2) 230 (C. C. A. 5)..... 3

In the Supreme Court of the United States

OCTOBER TERM, 1949.

No. 409.

THE MIDLAND STEEL PRODUCTS COMPANY,
Petitioner,

vs.

CLARK EQUIPMENT COMPANY,
Respondent.

REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

We have no quarrel with the rule stated by this Court in *Merrill-Ruckgaber v. U. S.*, 241 U. S. 378. In that case there was an ambiguity in a section of the contract and it was perfectly proper to go to other portions of the contract for an interpretation. This is very clear from the statement of the Court as follows:

> "*If we may concede to appellant an ambiguity* in the specifications, arising from the use of the singular word 'building,' instead of the plural word 'buildings,' against the material conditions which appellant's officers had inspected and knew of, and against, as well, *the other parts of the specifications*, which, among other things, call for 'rear walls' instead of a 'rear wall,' seemingly implying two buildings, and not one only, at the utmost it could only be said that there was ground for dispute, and, under the contract, the decision of the architect upon the dispute was final." (Emphasis ours.)

We think the emphasized portions alone show that this was a case where there was an ambiguity in one section of

the contract and resort was to be had to other portions to clear up the ambiguity.

No such situation exists in the case at bar.

The rule where a patent claim is not ambiguous was stated by this Court in *Graver v. Linde Air*, 336 U. S. 217, as follows (93 Law Ed. Advance Opinions p. 496):

> "It would accomplish little to require that claims be separately written if they are not to be separately read." *

There is no evidence in this cause that any of the claims presented by the Petition for Certiorari are ambiguous. The statement relied upon by Respondent, quoted from the opinion of the Court of Appeals and appearing at the top of page 8 of Respondent's Brief, is not evidence of ambiguity. At most it is a further resort by the Court of Appeals to extraneous matter to interpret an unambiguous claim. Indeed, it is a second resort to the specification for that purpose since the Court either went to the specification to determine what the Court thought to be the inventor's fundamental idea or else went beyond the four corners of the patent to do so.

Moreover, even if this expression were construed to be a finding of ambiguity and that was sufficient to establish

---

* In view of the very clear statement of the general rule of construction of parts of contracts in these two decisions of this Court, it seems unnecessary for us to go through and point out the facts in each of the many decisions cited at pages 6 and 7 of Respondent's Brief. Either these decisions fall on one side or the other of this rule, or else they show the existence of the very confusion on this subject which is one of the salient and dominant reason for this Court settling the matter. In other words, if these decisions are authority for going to the specification to interpret an unambiguous claim, then they are contrary to the rule of contracts, the rule in the British Courts, the rule in this Court and the rule in the Fifth Circuit. If so, they are commanding reasons for settling the question here presented. If the claims in those cases were ambiguous and, therefore, resort is had to the specification, they are immaterial here, just as this Court's decision in *Merrill-Ruckgaber v. U. S., supra*, is immaterial.

ambiguity, it would apply only to the method claims. Of the claims before this Court the following are apparatus claims to which it would not apply:

Claims 4, 8 and 16 of Patent No. 2,139,771,
Claim 7 of Patent No. 1,948,801, and
Claims 26 and 30 of Patent No. 2,061,671.

The claims listed in the section numbered (1) on page 3 of our Main Brief are not involved here since these were the ones that recite the full depth limitation. It is manifest that the Court below did not consider that the prior art forced a limitation on the other claims since the Court went to the specification to find a justification in the Court's mind for reading this limitation into the claims listed in sections (2), (3) and (4) on page 3 of our Main Brief.

The prior art can no more be resorted to to construe an unambiguous claim than the specification of the patent. The rule is that an unambiguous section of a contract must be interpreted within its own four corners. Indeed, resort to prior art to construe an unambiguous claim is even more remote and a more flagrant violation of the rule than resort to the specification which this Court said could not be done in *Graver v. Linde Air, supra.** If the Court of Appeals had thought the claims recited in sections (2), (3) and (4) at page 3 of our Main Brief were anticipated by the prior art, such would no doubt have been the Court's pronouncement. However, the Court did not think so and, therefore, went to the specification to read or construe the limitation into the unambiguous claims to establish non-

---

* In *Wayne v. Humble*, 175 Fed. (2) 230 (CCA 5) the Court there refused to do just what Respondent asserts the Sixth Circuit Court of Appeals did here, i.e., the Fifth Circuit Court of Appeals refused to read or construe a limitation in the unambiguous claims to save them from the prior art. Thus Respondent points to a second diversity of decision relating to an important principle of patent law existing here between these Circuits. In the instant cause the claims could not be held invalid, as in the Fifth Circuit case, because of the estoppel to deny validity, and hence the reading or construing of the limitation into the claims.

infringement, all in diversity with the rule in the Fifth Circuit which is supported by the general rule of contracts, the rule followed in the British Courts, as we pointed out at pages 8 and 9 of our Main Brief.

The forepart of Respondent's Brief is replete with errors apparently presented as red herrings; all these are immaterial to the single and simple issue here. Only one merits mention. The Court of Appeals said it refused to extend the doctrine of equivalents to include the prior art with respect to the claims not included in this Petition (i.e., those included in section (1), p. 3 of our Main Brief). Whether the Court of Appeals was correct or not is immaterial here since those claims are not at issue here and the claims included in our Petition differ from the prior art in other particulars, hence the Court of Appeals read or construed into the latter group the full depth seam and melting "in the light of the specification" to create a non-infringing limitation; the propriety, or impropriety, of doing so, in view of the diversity of views on the subject in the Circuits, is the issue here.

We think Respondent's Brief is very helpful in showing the confusion which exists on this subject and the great need of settling the question by this Court once and for all, i.e., the question of whether or not a patent, which is recognized to be a contract, comes within the rule of contracts to the effect that an unambiguous section of the contract may not be varied or interpreted in the light of matter extraneous thereto, even though it be some other section of the contract.

Respectfully submitted,

F. O. RICHEY,
H. F. MCNENNY,
Attorneys for Petitioner.

RICHEY & WATTS,
1150 Union Commerce Bldg.,
Cleveland, Ohio,
Of Counsel.

FREE COPY

NOV 21 1949

CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. 409

THE MIDLAND STEEL PRODUCTS COMPANY,
Petitioner,

vs.

CLARK EQUIPMENT COMPANY,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

JOHN A. DIENNER,
EDWARD C. GRELLE,
Counsel for Respondent.

53 W. Jackson Blvd.,
Chicago 4, Illinois.

THE GUNTHORP-WARREN PRINTING COMPANY, 810 WEST JACKSON, CHICAGO

INDEX.

PAGE

Patents in Suit Not First to Solve Problem of Welding Thick-Walled Tubes 1

Petitioner's Drawings Are Misleading 1

Fusion Weld is the Fundamental Idea of Patents in Suit 2

Court of Appeals Held No Need to Decide Estoppel Issue 2

Public Interest is Adequately Protected 3

Petitions Are Not Granted to Give Defeated Party Another Hearing 3

Welding Industry is Not Concentrated in Sixth Circuit 3

Court Did Not Hold That Difference Between Patented Device and Accused Device is a Mere Difference in Degree 5

Court Limited Claims in View of Prior Art and Statement That Claims Must Be Interpreted "in the light of the specifications", Whether Right or Wrong Does Not Change Holding of Non-Infringement 5

Statement in Opinion That Claims Must Be Interpreted "in the light of the specifications" is a Correct Statement of the Law 6

Petitioner's Quotation From the Opinion is Incomplete and Misleading 7

The Claims in Question Were Held to be Ambiguous 7

There is No Conflict of Decisions 8

A Patentee is Not Entitled to a Monopoly Beyond the Scope of His Invention 8

Table of Cases.

Aero Spark Plug Co. v. V. G. Corp., 130 F. (2d) 290, 291 (C. C. A. 2nd) 7
American Construction Co. v. Jacksonville, Tampa and Key West Railway Co., 148 U. S. 372, 382 3
Corcoran v. Riness, 128 F. (2d) 870, 872 (C. C. A. 9th) 7
General Motors Corp. v. Kesling, 164 F. (2d) 824, 828 (C. C. A. 8th) 7
Graver Mfg. Co. v. Linde Air Products Co., 336 U. S. 271 8
Hutzler Bros. Co. v. Sales Affiliates, 164 F. (2d) 260, 263 (C. C. A. 4th) 7
Hydraulic Press Mfg. Co. v. Williams, White & Co., 165 F. (2d) 489, 493 (C. C. A. 7th) 7
Keller v. Adams-Campbell, 264 U. S. 314 5
Magnum Import Company, Inc. v. Coty, 262 U. S. 159, 163 3
Mertill-Ruckgaber Co. v. United States, 241 U. S. 387, 17 C. J. S., Contracts § 297 7
Remington Rand, Inc. v. Meilink Steel Safe Co., 140 F. (2d) 519, 521 (C. C. A. 6th) 7
Schriber-Schroth Co. v. Cleveland Trust Co., et al., 311 U. S. 211 6
Scott Paper Co. v. Marcalus Co., 326 U. S. 249 9
Wayne v. Humble Oil, 175 F. (2d) 230 8
Wayne v. Texas, 175 F. (2d) 234 8
Yates v. Jones, 82 U. S. P. Q. 337 8

Text.

17 C. J. S. Contracts § 297 7

Statutes.

Rev. Stats. 4916 5

IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. 409.

THE MIDLAND STEEL PRODUCTS COMPANY,
Petitioner,

vs.

CLARK EQUIPMENT COMPANY,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

Petitioner attempts to create the impression that the alleged inventions of the patents in suit were the first to solve the problem of welding thick walled tubes and that they have been accepted and used as a solution of the problem. This is not correct. The record shows that Respondent welded thick walled tubes prior to the patents in suit (R. 318, 324, 327). Only one welding machine was built in accordance with the alleged inventions of the patents in suit and that was built by Petitioner.

The drawings, Figures A, B, C and D, appearing opposite page 2 of the Petition, are misleading. Respondent welds tubing 5/16″ thick, for truck axle housings (R. 537), whereas Petitioner welds tubing 5/32″ thick, for passenger car axle housings (R. 536, 318, Defendant's Ex. D-38

at p. 199). Petitioner's tubing is only one half the thickness of Respondent's tubing. The welding of such a thick-walled tubing, as was required for Respondent's truck axle housings, presented a difficult problem. A fusion weld, such as Petitioner's, was not the answer, because it required too much heat and would not weld fast enough due to the thickness of the stock. It required nearly a year of experimentation by the best brains in the General Electric Company to develop and perfect the machine and process used by Respondent in producing its solid phase weld, and on which Catlett patents Nos. 2,282,031 and 2,282,032 were granted.

Petitioner refers to the fusion weld of the patents in suit, in which the edges are open for the full depth thereof and melted for the full depth, as being the preferred form of the invention. This was the fundamental idea of the inventor; it was the only form disclosed in the specifications and, as stated by the Court of Appeals, "Without consideration of the inventor's fundamental idea, neither the method nor its separate and interrelated steps would be intelligible."

Petitioner states that the District Court held Respondent was estopped to deny validity of the patents and that this holding was not disturbed by the Court of Appeals. The Court of Appeals held, in view of their conclusion of non-infringement, that "we have no need to decide whether appellee is estopped to deny validity."

Petitioner refers to three cases in which this Court granted certiorari in view of the questions presented and "because the patent dominates a substantial portion of an industry," so concentrated in one circuit that litigation in other circuits is unlikely. Petitioner contends that precisely the same situation exists in the instant cause.

In each of the three cases referred to by Petitioner, the

Court of Appeals had found the patents valid and infringed, and had issued an injunction restraining the Defendant from further infringement. In view of the decision of the Court of Appeals, the patents dominated a substantial portion of the industry, and public interest required a review of the decision by this Court. In the instant cause, the Court of Appeals held that the patents were not infringed, did not hold the patents valid and did not issue an injunction, but dismissed the complaint. Consequently, the decision in the instant cause not only does not enforce a patent monopoly which dominates a substantial portion of an industry, but does not enforce a patent monopoly at all and, therefore, public interest is adequately protected.

Petitions for writs of certiorari are not granted merely to give the defeated party in the Court of Appeals another hearing.

> *American Construction Company* v. *Jacksonville, Tampa and Key West Railway Company,* 148 U. S. 372, 382.
>
> *Magnum Import Company, Inc.* v. *Coty,* 262 U. S. 159, 163.

The patents in suit relate to the welding of tubing, which is a nationwide industry not concentrated in the Sixth Circuit. While the axle housing industry may be concentrated in the Sixth Circuit, as asserted by Petitioner, yet the tube welding industry is not so concentrated and the patents in suit relate to the tube welding industry and not the axle housing industry.

Petitioner states, on page 3 of the Petition:

> "The difference between plaintiff's preferred form and defendant (respondent here) is, therefore, one of degree and not one of kind, as the Sixth Circuit Court of Appeals held (174 Fed. (2) 544). This dif-

ference of degree, as the same Court held, would not avoid infringement, except that the limitation to the full depth was construed erroneously, or read into the unambiguous claims in suit by that Court, as we point out hereinafter."

This statement is completely erroneous.

Briefly, what the Sixth Circuit Court of Appeals held, as to these points, is as follows:

"Were there no prior art and no history in the patent office in respect to the patents in suit, it would seem to be a simple matter to conclude that the charge of infringement had been sustained by the application of the principle that a difference in degree does not avoid infringement, by resort to the doctrine of equivalency and to those inferences that sometimes are said to flow from the acceptance of a license for a patented device. But the teachings of the art, the experience of the inventor with his applications and the circumstances under which the license was granted, present a different aspect. Riemenschneider was not a pioneer in arc welding methods and came into a crowded art. This he frankly concedes in his 112 patent. * * *"

"The machine finally produced by Catlett [the accused machine] operated, in the main, on the principle of solid phase welding which Catlett later described in patents. The minimum fusion at the top of the weld could have been avoided except for economic reasons, though Catlett's process produced a forged weld for about 60% of the depth of the seam.

The concept of Riemenschneider as derived from a study of his patents and their patent office history, going back to his abandoned application of 1930, was that his invention involved spaced-apart edges of the tube and a melting flame projected to the full depth of the seam. It was only by incorporating this step in his process that he was able to distinguish his invention from prior art so as to be granted patents thereon. * * *"

> "In view of these circumstances we are of the view that the patents in suit are of narrow scope, that they must be confined to fusion welding for the full depths of the seam, created by spaced-apart edges, and do not extend beyond that limited area."

From the foregoing quotations, it is clear that the Court did not hold that the difference between the patented device and the accused device was a mere difference of degree. It should also be noted that the Court limited the claims in view of the prior art. Petitioner does not question the soundness of this portion of the opinion, in which the Court limits the claims in view of the prior art, but bases its grounds for certiorari on one isolated paragraph of the opinion in which the Court said that the claims must be interpreted "in the light of the specifications." Even if this statement were incorrect, it would not affect the outcome of the case and be grounds for certiorari, since the interpretation and limitation of the claims was also in view of the prior art.

In *Keller* v. *Adams-Campbell*, 264 U. S. 314, this Court granted certiorari on the assumption that the case involved an important question of intervening rights under Rev. Stats. 4916. The Court of Appeals had said, in its opinion:

> "We, therefore think it clear that the appellees had and have such intervening rights as were properly protected by the court below."

When it was found that the Court of Appeals had also held that there was no infringement of the patents in suit, this Court dismissed the writ of certiorari, saying at pages 319 and 320:

> "These passages read in connection with the original and reissued patents and the alleged infringement show that what the courts really held was that the defendants were manufacturing a different in-

> vention from that of the plaintiffs, and so could not and did not infringe. Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent. We therefore find ourselves mistaken in assuming that an important issue of general patent law under § 4916, Rev. Stats., is here involved. The result is that an order must be entered dismissing the writ of certiorari as improvidently granted at the costs of the petitioner."

Similarly, in the case at bar, the fact that the Court of Appeals held that the claims must be interpreted and limited in view of the prior art disposes of the case, and the statement that the claims must be interpreted "in the light of the specifications," whether right or wrong, does not change the holding of non-infringement and is not a valid ground for granting certiorari.

While we believe that the foregoing is a sufficient reason for denying the Petition, we wish also to point out that the statement in the opinion of the Court of Appeals, that the claims must be interpreted "in the light of the specifications," is a correct statement of the law, that it is in accordance with the decisions of this court and many other courts, and that there is no conflict of decisions on this point.

In the recent decision, *Schriber-Schroth Co.* v. *Cleveland Trust Co., et al.,* 311 U. S. 211, this Court said at page 217:

> "The claims of a patent are always to be read or interpreted in the light of its specifications, *Hogg* v. *Emerson,* 11 How. 587; *Carnegie Steel Co.* v. *Cambria Iron Co.,* 185 U. S. 403; *Smith* v. *Snow,* 294 U. S. 1."

This is an old and well established proposition of law and is universally followed by all the courts.*

Petitioner argues that a patent is a contract and that, therefore, the claim cannot be read in the light of the specification. It is a fundamental rule of contract law that the contract must be construed as a whole and not from detached portions. *Mertill-Ruckgaber Co.* v. *United States,* 241 U. S. 387, 17 C. J. S., Contracts § 297.

The Petition for Certiorari in the instant cause is based on a quotation from the opinion of the Court of Appeals, which omits the first and last sentences of the paragraph from which the quotation is taken. The complete paragraph is as follows:

> "We have no quarrel with the appellee's statement of law that an element cannot be read into a claim in order to make out a case of non-infringement. Certain of the claims, it urges, say nothing about the full depth of the seam or the reduction of the edges to a molten condition for their full depth, and therefore it urges that these elements may not be read into such claims. The inventor's concept of his invention so clearly involves the spaced-apart edges and their molten condition to their full depth that none of the claims may, in the light of the specifications, be interpreted without recognition of that concept, and the steps in the method which are expressed in the claims, are a necessary and inescapable response to

---

* *Aero Spark Plug Co.* v. *V. G. Corporation,* 130 F. (2d) 290, 291 (C. C. A. 2nd).
Hutzler Bros. Co. Sales Affiliates, 164 F. (2d) 260, 263 (C. C. A. 4th).
Remington Rand, Inc. v. *Meilink Steel Safe Co.,* 140 F. (2d) 519, 521 (C. C. A. 6th).
Hydraulic Press Mfg. Co. v. *Williams, White & Co.,* 165 F. (2d) 489, 493 (C. C. A. 7th).
General Motors Corporation v. *Kesling,* 164 F. (2d) 824, 828 (C. C. A. 8th).
Corcoran v. *Riness,* 128 F. (2d) 870, 872 (C. C. A. 9th).

it. Without consideration of the inventor's fundamental idea, neither the method nor its separate and interrelated steps would be intelligible."

The first sentence of the above paragraph shows that the Court did not overlook the rule of law, that an element cannot be read into a claim in order to make out a case of non-infringement. The last sentence constitutes a holding that the claims in question are ambiguous and not intelligible without consideration of the inventor's fundamental idea, *i. e.*—"the spaced-apart edges and their molten condition to their full depth." This holding disposes of Petitioner's entire Petition, which is based on the false premise that the claims in question are unambiguous.

There is no conflict of decisions, as is urged by Petitioner, between the decision in the instant cause and the decisions in *Wayne* v. *Humble Oil,* 175 F. (2d) 230; *Wayne* v. *Texas,* 175 F. (2d) 234, and *Graver Mfg. Co.* v. *Linde Air Products Co.,* 336 U. S. 271. In those decisions the claims were unambiguous. Also, in those decisions the Court was passing on the issue of validity, whereas in the instant cause and in *Yates* v. *Jones,* 82 U. S. P. Q. 337, referred to by Petitioner, the Court was passing on the issue of infringement.

A patentee is not entitled to a monopoly beyond the scope of his invention.

In applying this concept to the issue of validity, the Courts hold that a claim which is broader than the invention is invalid. See *Graver Mfg. Co.* v. *Linde Air Products Co.,* 336 U. S. 271.

In applying this concept to the issue of infringement, the Courts hold that a claim must be limited to the actual invention and advance over the prior art and will not be enforced to extend the scope of the patentee's monopoly

beyond the scope of the invention. See *Scott Paper Co.* v. *Marcalus Co.*, 326 U. S. 249.

Both of these propositions of law are well established and do not conflict when properly understood. They both give effect to the basic principle that a patentee is not entitled to a monopoly beyond the scope of his invention.

In the case at bar, a patent infringement suit, Petitioner is trying to extend the scope of the patent monopoly beyond the scope of the invention. This Court should not give its aid to any such attempt.

The Petition is without merit and should be denied.

Respectfully submitted,

JOHN A. DIENNER,
EDWARD C. GRELLE,
Counsel for Respondent.

53 W. Jackson Blvd.,
Chicago 4, Illinois.